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10/643,291	08/19/2003	Akihiko Taniguchi	501152.20019	4056

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EXAMINER
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FAISON GEE, VERONICA FAYE

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 12/14/2006

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/643,291  
Filing Date: August 19, 2003  
Appellant(s): TANIGUCHI ET AL.

**MAILED**

DEC 14 2006

**GROUP 1700**

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Eugene LeDonne  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 10-5-06 appealing from the Office action  
mailed 5-16-06.

**(1) Real Party in Interest**

The real party in interest is Brother Kogyo Kabushiki Kaisha.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**WITHDRAWN REJECTIONS**

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner. The 102(e) rejection of claims 4, 8 and 11 have been withdrawn in view of appellant's arguments.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

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**(8) Evidence Relied Upon**

6,695,900

Momose

2-2004

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 3, 4, 7, 8 and 11 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 9 of copending Application No. 10/387,739. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application overlap said published claims and would be obvious thereby.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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**“Products of identical chemical composition can not have mutually exclusive properties.” A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).**

***Claim Rejections - 35 USC § 102***

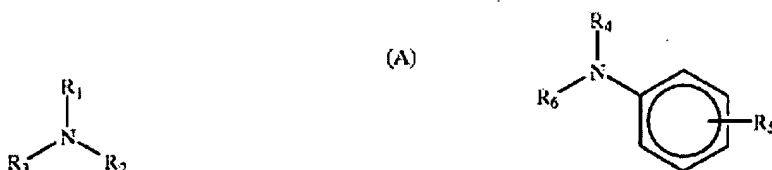
The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3 and 7 are rejected under 35 U.S.C. 102(e) as being anticipated by Momose (US Patent 6,695,900).

Momose teaches an aqueous ink composition comprising at least a surface-modified pigment capable of being dispersed without the use of a dispersant, an organic amine compound represented by formula (A) or (B) shown below and water



wherein R<sub>1</sub> to R<sub>6</sub> each independently represents a hydrogen atom or an alkyl or hydroxyalkyl chain having from 1 to 8 carbon atoms (abstract, col. 2 lines 39-65, col. 4

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lines 31-45). See Table 1, compounds 1 and 2 for the limitations set forth in claim 3.

The reference remains silent to the curve that represents a change of surface tension of the ink. However, it is the position of the Examiner that because the reference teaches a surfactant (formula A) which meets the requirements set forth by Applicant that the compound would inherently have the same properties. The reference further teaches that the ink composition may be used in any printing method including ink jet recording method (col. 7 lines 40-59). The ink composition as taught by Momose appears to anticipate the claimed invention.

***Allowable Subject Matter***

Claims 4-6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: The references alone or in combination fail to teach an ink composition comprising an alkyamine ethylene oxide adduct represented by formula (1) wherein  $x + y = 5$  or 15.

Claims 8-11 are allowed.

The following is an examiner's statement of reasons for allowance: The references alone or in combination fail to teach an ink composition comprising an alkyamine ethylene oxide adduct represented by formula (1) wherein  $x + y = 5$  to 15.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably

accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

**(10) Response to Argument**

Applicant's arguments, filed 10-5-06, with respect to claims 4, 8 and 11 have been fully considered and are persuasive. The rejection of claims 4, 8 and 1 has been withdrawn.

Applicant's arguments filed 10-5-06 have been fully considered but they are not persuasive for claims 1, 3 and 7.

Applicant argues that "nowhere does Momose disclose the concentration of surfactant claimed in Claim 1".

The Examiner would like to point out that no specific concentration range is present in claim 1, therefore it is irrelevant that Momose disclose the concentration of the surfactant.

Applicant argues that the curve of Claim 1 is not an inherent property of the ink disclosed in Momose since Momose fails to disclose an anionic self-dispersing coloring agent.

The Examiner would like to point out the surface-modified pigment, which is capable of at least one of dispersing and dissolving in an aqueous solvent without use of a dispersant. The hydrophilic functional group is selected from of a carboxyl group and sulfone group with are some of the same groups that applicant has disclosed on page 7 of the specification. Applicant states that the curve has its properties because the cationic moiety of the surfactant adheres to the anionic self-dispersing agent.

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Momose has all of the components that Applicant claims gives the properties of the curve, therefore Momose would inherently have the properties of the curve.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Veronica Faison-Gee

Conferees:



**Jennifer Michener**  
**QAS - Appeals**  
**TC 1700**

Jennifer Michener



**DAVID SAMPLE**  
**PRIMARY EXAMINER**

Jerry Lorengo *for:*